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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/202,305 03/22/99 MANOLIOS

N 06025.0003

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HM12/0523

EXAMINER

GLIETA, A	
ART UNIT	PAPER NUMBER

1653
DATE MAILED:

15
05/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/202,305

Applicant(s)

Manolois, N

Examiner

ANISH GUPTA

Art Unit

1653



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 8, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above, claim(s) 4, 9-11, 14, and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8, 12, and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Election/Restriction

I. Applicant's election with traverse of Group I and the species of SEQ ID. No. 7 in Paper No. 7 and 13 is acknowledged. The traversal is on the ground(s) that for the restriction the Examiner has not established that Group I and Group II are independent and distinct invention and a search and examination could not be made without serious burden. Applicants argue that both Group I and Group II require the use of the peptides and therefor the method of claim cannot be practiced with a materially different product. This is not found persuasive because of the following reasons.

First as to the burden of search, a search on Group I would be carried out based on the peptides alone. However a search for Group II would be carried out based on a peptide conjugate. Say if the peptide is conjugated to a larger protein, the search would note in the same class and subclass as Group I. The method of Group II involves the use of a peptide conjugate rather than the peptide themselves. Further, if the peptide conjugated to another peptide, as claimed in Group II, is found, Applicant would not acquiesce that this compounds anticipates or renders obvious the peptides of Group I. Indeed the compounds used for Group I and Group II are structurally distinct. Finally, since the search would be conducted based on structure, there would be undue burden to search both Group I and Group II.

Applicants also contend that Group I and Group II both utilize the same peptide. However, this not entirely correct. The method of Group II, utilizes a peptide conjugate. Although the peptides used are the same as Group I, the are part of a larger structure. The search would be conducted on this larger structure. Finally, although Applicants argue that the method require the use of the claimed peptides, the method of delivering a chemical moiety to a cell can be practiced with a materially different product. That is, the method is not unique only to those peptides claimed.

For Election of Species, Applicants have stated that the PTO has previously indicated that it will search up to 10 sequences in given application. "Thus, applicant is surprised and concerned with the present species election, which appears to ignore the accepted PTO practice." The assertion regarding accepted PTO practice is not persuasive. The MPEP and O.G. Notice, for example MPEP 803.04, does not include proteins and peptides. Thus, assertion of the same in the response is unpersuasive and there is no per se 10 sequence rule applicable to proteins and peptides.

The requirement is still deemed proper and is therefore made FINAL.

A search was carried out on the elected species of SEQ ID No. 7. This species was free of prior art and thus the search was extended to SEQ ID 6, 8-15, 17-2. These species were also deemed to be allowable. In accordance with markush practice, a search extended to the Markush-type claim 1 and prior art was found that anticipates or renders obvious this Markush-type. Claims 1-3, 6, 13 have been examined to the extent they read on the prior art. Claims drawn to the nonelected species, claims 4, 9, 10-11, 14-15 are held withdrawn from further consideration

Claim Objections

2. Claims 5-7, 12-13 are objected to under 37 C.F.R. § 1.75 as being in improper form because a multiple dependent claim should refer to other claims in there alternative and cannot depend on any other multiple dependent claim. See M.P.E.P. § 608.01(n).

3. Claim 8 is objected to because of the following informalities: Applicants are requested to recite the SEQ ID NO: for the peptide claimed. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1-3, 5-8, 12 and 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, it is unclear what TCR means. Applicants are requested to spell out TCR in the claim.

In claim 1, it is unclear if A and B are selected as a variable or amino acids. A is the single letter designation for "Ala" and B is the single letter designation for "Asx". It is believed applicants intend A and B to be variables. Applicants are, therefore, requested to use some other designator.

Claim 13 recites a therapeutic composition. However, it is unclear what the composition is active against to render it a therapeutic.

Claim 12 is dependant upon a withdrawn claim. Appropriate correction is requested.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 6, 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Mozes et al.


The claims are drawn hydrophobic peptide and therapeutic composition thereof of which the below peptide are within the scope of the present claims.

The reference teach the peptide LLVIVELIPSTSSAV that read on the claimed peptide of claim 1 (see page 11, line 30-37). Note that peptide of the reference have at least 50% hydrophobic amino acid, and the B variable corresponds to a glutamic acid, as claimed in claim 3 and 6 of the instant application. The reference further teach pharmaceutical composition for the treatment of myasthenia gravis (see page 11, lines 30-37). It is well known in the art myasthenia gravis is a disorder in which T-Cells are involved. Thus the reference anticipates the claimed invention.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Gupta whose telephone number is (703) 308-4001. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can normally be reached on (703)308-2923. The fax phone number of this group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.


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